

REMARKS

In view of the above amendments and the following remarks, reconsideration of the outstanding office action is respectfully requested.

The rejection of claims 1, 3-6, 10-12, and 38-40 under 35 U.S.C. § 103(a) for obviousness over U.S. Patent No. 5,373,678 to Hesser et al. ("Hesser") in view of U.S. Patent No. 6,277,468 to Nakamoto et al. ("Nakamoto") is respectfully traversed.

Hesser discloses a structural wall apparatus including a plurality of building panels disposed in edge to edge relationship and a plurality of panel connecting fasteners attaching the panels together. Each panel has outer and inner metal skins spaced by an intermediate insulating core and has at least one interlocking edge. The interlocking edge of each panel has a metal lined tongue and a metal lined groove shaped for each metal tongue to fit into opposing grooves on abutting panels for interlocking the panels together. Each panel has an elongated reinforcing member positioned adjacent the interlocking edge of the panel and having a channel formed therein shaped to fit around the metal lined groove portion and having a skin attaching flange on one side for attaching the reinforcing member to the metal skin and a strengthening flange portion on the other side of the metal lined groove. The panel connecting fasteners attaches the panels together by having one elongated fastener passing through the panel skin and through the elongated reinforcing member skin attaching flange and through the reinforcing member channel and through the metal lined groove and the metal lined tongue of the second panel and through the elongated reinforcing member strengthening flange on the other side of the metal lined groove to provide greater strength to the connecting edges of the attached panels. Additional fasteners attach the panels to a frame and also attach the elongated reinforcing member to the metal skin of a panel.

Nakamoto discloses a paper-laminated metal sheet having a structure in which at least one sheet of paper is laminated on at least one side of a metal plate via a pressure sensitive adhesive agent or an adhesive agent layer.

Claim 1 of the present application, as well as dependent claims 3-6 and 10-12, is directed to a "building panel of sandwich construction comprising a core and spaced metal sheets fixed to opposite major faces of said core, said core including opposite end edges which extend between said opposite major faces thereof, said panel having opposite major surfaces and opposite longitudinal edge regions . . . wherein at least one of said metal sheets has a paper covering bonded thereto so that said metal sheet forms one of the major surfaces

of the panel, wherein the paper covering provides a surface characteristic that enables said major surfaces of the panel to be finished to appear continuous by using finishing techniques, wherein the panel is configured such that the major surfaces of the interconnected panels incorporating the paper covering are aligned and in substantially abutting relationship to form a continuous surface, wherein said finishing techniques are applied to the major surfaces of the interconnected panels.” Claim 38 of the present application, as well as dependent claims 39-40, is directed to a “building panel comprising a metal sheet substrate and a paper covering bonded to said substrate, wherein said paper covered metal sheet forms a major surface of the panel with the paper covering providing a surface characteristic to that major surface that is structured to be finished using conventional finishing techniques, and wherein said metal sheet includes opposite edges which are shaped to form edge regions of the panel, each edge region being formed to include a connecting element which extends along that edge region and which allows for interconnection of the panel with another panel, and wherein when interconnected, the major surfaces of the interconnected panels are aligned and in substantially abutting relationship to enable a continuous surface to be obtained on applying the conventional finishing techniques to the paper covered major surfaces of the interconnected panels.”

Hesser does not teach or suggest a building panel that has metal sheets having a “paper covering” bonded to the metal sheets, as required by the claims of the present invention. The U.S. Patent and Trademark Office (“PTO”) cites Nakamoto for teaching a building panel having sheets with a paper covering. However, as shown by the § 102(e) date of Nakamoto (i.e., May 13, 1999), which is subsequent to the filing date of the present application (i.e., April 9, 1999), Nakamoto does not qualify as prior art under 35 U.S.C. § 102(e). In addition, Nakamoto is not prior art under 35 U.S.C. § 102(a), because the present application claims the benefit of Australian Patent Application No. PP2898, filed April 9, 1998, which is prior to the publication date of Nakamoto’s corresponding PCT publication of the international application (i.e., February 4, 1999). Applicant submits that the priority claim under 35 U.S.C. § 119 to the April 9, 1998, filing date of Australian Patent Application No. PP2898 (“the Australian priority application”) is perfected because the Australian priority application satisfies the enablement and description requirements of 35 U.S.C. § 112 (first paragraph).

Specifically, page 5, lines 10-14, page 9, lines 12-15 and 20-23, and Figures 3 and 3A of the Australian priority application disclose a building panel of sandwich construction comprising a core and spaced metal sheets fixed to opposite major faces of the core, the core including opposite end edges which extend between the opposite major faces thereof, where at least one of the metal sheets has a paper covering bonded thereto so that the metal sheet forms one of the major surfaces of the panel, as recited in claim 1 of the present application. Page 2, lines 30-32, page 7, lines 30-31, and Figures 1 and 1A of the Australian priority application disclose a building panel comprising a metal sheet substrate and a paper covering bonded to the substrate, where the paper covered metal sheet forms a major surface of the panel, as recited in claim 38 of the present application. Page 3, lines 22-25, page 5, lines 29-32, page 8, lines 5-6, page 9, lines 15-17 and 24-26, and Figures 3-5 of the Australian priority application disclose that each of the metal sheets comprises opposite edge regions which form the longitudinal edge regions of the panel and which extend inwardly of said opposite major surfaces of said panel to form a pair of connecting elements at each edge region of the panel, the connecting elements extending across the end edges of the core, the connecting elements of the longitudinal edge regions of the panel being adapted to interfit with the connecting elements of a respective one of the longitudinal edge regions of another panel to provide for interconnection of the panel with another panel, as recited in claims 1 and 38 of the present application. Page 8, lines 6-13, page 10, lines 13-30, page 11, lines 8-13, and Figures 3-5 of the Australian priority application disclose that each edge region of the panel is formed to include a channel or a projection, as recited in claims 1 and 39 of the present application. Page 3, lines 28-32, page 5, lines 16-17 of the Australian priority application disclose that the connecting elements of the longitudinal edge regions of the panel form a load bearing region capable of accommodating loading applied to the interconnected panels, as recited in claims 1 and 39 of the present application. Page 3, lines 8-11 and page 11, lines 8-13 of the Australian priority application disclose that the paper covering provides a surface characteristic that enables the major surfaces of the panel to be finished to appear continuous by using finishing techniques, where the panel is configured such that the major surfaces of the interconnected panels incorporating the paper covering are aligned and in substantially abutting relationship to form a continuous surface, where the finishing techniques are applied to the major surfaces of the interconnected panels, as recited in claims 1 and 38 of the present application. Thus, the Australian priority application provides

adequate written descriptive support for and contains disclosure which enables claims 1 and 38-39 of the present application.

In addition, Figures 3-8 of the Australian priority application disclose that the channel is generally C shaped in cross section incorporating opposite walls interconnected by a substantially flat base portion, as recited in claim 3, and that the angle between the opposite walls and the base portion is approximately 90° so that the channel forms a part box section, as recited in claim 4 of the present application. Page 10, lines 21-23 and Figure 5 of the Australian priority application disclose that the projection interfits in nesting engagement within the channel of the another panel, as recited in claim 5, and that the projection has an outer surface which is complimentary to the inner surface of the channel so that on interconnection of the panels, the projection is in engagement with substantially all of the inner surface of the channel of the another panel, as recited in claim 6 of the present application. Thus, the Australian priority application provides adequate written descriptive support for and contains disclosure which enables claims 3-6 of the present application.

Additionally, page 4, lines 13-14, page 7, lines 30-31, page 9, lines 20-23, and page 13, lines 5-17 of the Australian priority application disclose that the paper covering is bonded to the substrate using a reactive hot melt adhesive, as recited in claim 10 of the present application. Thus, the Australian priority application provides adequate written descriptive support for and contains disclosure which enables claim 10 of the present application.

In addition, page 2, lines 30-32, page 3, lines 17-19, page 4, lines 17-19, page 7, lines 30-31, page 9, lines 20-23, and page 13, lines 13-15 of the Australian priority application disclose that the paper is bonded directly onto the metal substrate, as recited in claim 11 of the present application. Thus, the Australian priority application provides adequate written descriptive support for and contains disclosure which enables claim 11 of the present application.

Finally, page 3, lines 17-19 and page 9, line 31 – page 10, line 8 of the Australian priority application disclose that the panel is formed in continuous lengths using a laminating process to adhere the paper covering to the metal substrate, as recited in claims 12 and 40 of the present application. Thus, the Australian priority application provides adequate written descriptive support for and contains disclosure which enables claims 12 and 40 of the present application.

Therefore, because the Australian priority application provides adequate written descriptive support for and contains disclosure which enables claims 1, 3-6, 10-12, and 38-40 of the present application, Nakamoto is not prior art under 35 U.S.C. § 102(a). Since Hesser does not teach or suggest a building panel that has metal sheets having a “paper covering” bonded to the metal sheets, as required by the claims of the present invention, and Nakamoto is not prior art, the rejection of claims 1, 3-6, 10-12, and 38-40 is improper and should be withdrawn.

The rejection of claims 2, 14, and 15 under 35 U.S.C. § 103(a) for obviousness over Hesser in view of Nakamoto and further in view of U.S. Patent No. 6,314,701 to Meyerson (“Meyerson”) is respectfully traversed.

As noted above, Hesser does not teach or suggest a building panel that has metal sheets having a “paper covering” bonded to the metal sheets, as required by the claims of the present invention.

As noted above, Nakamoto does not qualify as prior art under 35 U.S.C. § 102(e). Further, Nakamoto is not prior art under 35 U.S.C. § 102(a), because the Australian priority application provides adequate written descriptive support for and contains disclosure which enables claims 2, 14, and 15 (which are dependent from claim 1) of the present application.

Specifically, page 7, line 31 – page 8, lines 2, page 10, lines 18-23, and Figures 3-5 of the Australian priority application disclose a building panel further comprising a generally planar abutment surface at each longitudinal edge region of the building panel, the abutment surface extending generally perpendicular to the major surfaces of the panel and where the connecting elements are disposed inwardly of the at least one major surface of the panel having the paper covering with the abutment surfaces being disposed between the major surface and the connecting elements, where the paper covering gives the panel a surface characteristic which is substantially the same as a plasterboard panel and where, in use, the panel is operative to form an exposed surface by connection of the panel with another panel through interfitting of respective ones of the connecting elements, as recited in claim 2 of the present application. Also, page 3, lines 25-28 of the Australian priority application discloses that the panel is operative to form an exposed surface by abutment of an edge of a plasterboard panel against a respective one of the abutment surfaces, as recited in claim 2 of the present application. Thus, the Australian priority application provides adequate written

descriptive support for and contains disclosure which enables claim 2 of the present application.

In addition, page 4, lines 4-7 and page 8, lines 2-4 of the Australian priority application disclose a building panel where the metal substrate is selected from the group consisting of mild steel, aluminum, tin, stainless steel, and galvanized steel, as recited in claim 14 of the present application. Thus, the Australian priority application provides adequate written descriptive support for and contains disclosure which enables claim 14 of the present application.

Finally, page 4, lines 9-10 of the Australian priority application discloses a building panel where the gauge of the metal substrate is between 0.3 to 1 mm, as recited in claim 15 of the present application. Thus, the Australian priority application provides adequate written descriptive support for and contains disclosure which enables claim 15 of the present application.

Therefore, because the Australian priority application provides adequate written descriptive support for and contains disclosure which enables claims 2, 14, and 15 of the present application, Nakamoto is not prior art under 35 U.S.C. § 102(a).

Meyerson is cited for disclosing abutment surfaces extending generally perpendicular to the major faces of a building panel. Meyerson, however, does not disclose or suggest a paper covering bonded to metal sheets, as required by the claims of the present invention.

Since Nakamoto is not prior art and Hesser and Meyerson, either alone or in combination, fail to teach or suggest each and every limitation of the claimed invention, applicant submits that the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.

The rejection of claim 7 under 35 U.S.C. § 103(a) for obviousness over Hesser in view of Nakamoto and further in view of Meyerson is respectfully traversed.

As noted above, Hesser does not teach or suggest a building panel that has metal sheets having a "paper covering" bonded to the metal sheets, as required by the claims of the present invention.

As noted above, Nakamoto does not qualify as prior art under 35 U.S.C. § 102(e). Further, Nakamoto is not prior art under 35 U.S.C. § 102(a), because the Australian

priority application provides adequate written descriptive support for and contains disclosure which enables claim 7 (which is dependent from claim 1) of the present application.

Specifically, it is apparent from page 10, lines 21-23 and Figures 3-5 of the Australian priority application that the projection can be operative to interfit with a channel of the another panel, which supports the snap fit arrangement, as recited in claim 7 of the present application.

Therefore, because the Australian priority application provides adequate written descriptive support for and contains disclosure which enables claim 7 of the present application, Nakamoto is not prior art under 35 U.S.C. § 102(a).

Meyerson is cited for disclosing a snap fit connection between building panels. Meyerson, however, does not disclose or suggest a paper covering bonded to metal sheets, as required by claim 7 of the present invention.

Since Nakamoto is not prior art and Hesser and Meyerson, either alone or in combination, fail to teach or suggest each and every limitation of the claimed invention, applicant submits that the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.

The rejection of claim 9 under 35 U.S.C. § 103(a) for obviousness over Hesser in view of Nakamoto and further in view of U.S. Patent No. 5,860,693 to Ehrlich ("Ehrlich") is respectfully traversed.

As noted above, Hesser does not teach or suggest a building panel that has metal sheets having a "paper covering" bonded to the metal sheets, as required by the claims of the present invention.

As noted above, Nakamoto does not qualify as prior art under 35 U.S.C. § 102(e). Further, Nakamoto is not prior art under 35 U.S.C. § 102(a), because the Australian priority application provides adequate written descriptive support for and contains disclosure which enables claim 9 (which is dependent from claim 1) of the present application.

Specifically, page 11, lines 14-19 of the Australian priority application discloses that the edge region of the major surface of the panel incorporates a recess to facilitate concealment of a joint between the panel and another panel by using finishing techniques, as recited in claim 9 of the present application.

Therefore, because the Australian priority application provides adequate written descriptive support for and contains disclosure which enables claim 9 of the present application, Nakamoto is not prior art under 35 U.S.C. § 102(a).

Ehrlich is cited for teaching the major surface of the panel having a recess adjacent to the edge regions. Ehrlich, however, does not disclose or suggest a paper covering bonded to metal sheets, as required by claim 9 of the present invention.

Since Nakamoto is not prior art and Hesser and Ehrlich, either alone or in combination, fail to teach or suggest each and every limitation of the claimed invention, applicant submits that the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.

Further, since applicant is entitled to present product claims having process limitations for consideration, applicant respectfully declines the Examiner's suggestion to cancel claims 12 and 40.

Finally, the December 11, 2003, telephonic interview between Examiner McDermott and applicant's undersigned attorney is gratefully acknowledged. The following remarks summarize the presentation of the undersigned on the applicant's behalf during the interview.

Applicant submits that the final rejection is improper, because the new ground of rejection presented in the outstanding office action was not necessitated by applicant's amendment of the claims. The Examiner stated, in the above-mentioned interview, that applicant's amendment to claim 1 changed the scope by removing "plasterboard paper covering" and adding "paper covering" which necessitated the new ground of rejection. Applicant respectfully disagrees. Upon the present facts, changing the scope of the claims does not necessitate a new ground of rejection. If the reference cited by the Examiner disclosed a "plasterboard paper covering," it would also apply to a "paper covering" since a species can anticipate a genus. However, applicant submits that Nakamoto was substituted for the previously cited U.S. Patent No. 3,760,548 to Sauer et al. ("Sauer") because Sauer failed to disclose a "plasterboard paper covering," and not because the scope of the claim had changed. Thus, the inadequacy of the originally cited secondary reference, not the amendment, necessitated the new ground of rejection. Therefore, applicant respectfully requests that the finality of the rejection be withdrawn.

In view of the all of the foregoing, applicants submit that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

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Jan 21, 2004 Ruth R. Smith
Date Ruth R. Smith